

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

WILLIAM P. APPS

Serial No.: 09/836,045

Filed: April 16, 2001

For: STACKABLE LOW DEPTH TRAY

Attorney Docket No.: RPC 0544 PUS

Group Art Unit: 3727

Examiner: S. Castellano

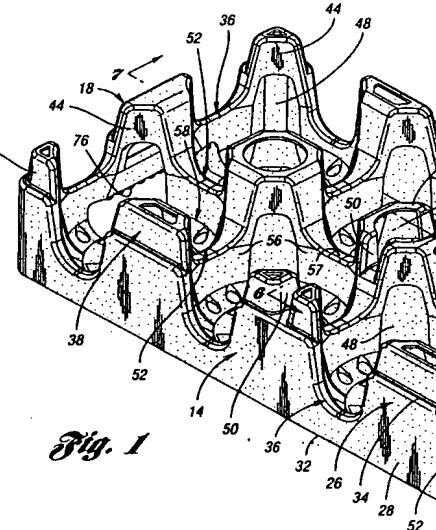
REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed June 18, 2004.

Appellant claims a low depth tray for bottles with interior divider walls which, *inter alia*, define pockets for retaining a single bottle in each pocket. Each divider wall includes two spaced apart, generally parallel surfaces extending between the same two columns or between the same column and the wall structure. The surfaces of divider walls 56 are disclosed in the application as spaced apart by top surface 52 (see, adjacent portion of application Fig. 1).



Rejections Under 35 U.S.C. §§ 102(b) and 102(e)

In the Examiner's Answer, the Examiner has improperly set forth a new, albeit not better, argument of anticipation under 35 U.S.C. §§ 102(b) and 102(e) without indicating that this new argument supersedes the argument previously set forth in the final rejection (M.P.E.P. § 1208, Page 1200-17, 8th edition). Specifically, the Examiner abandons his previous argument that "a divider wall" as claimed by Appellant is disclosed in the cited references as "two of the ten walls which are parallel to each other and spaced transversely from each other and are transversely aligned" or "two of the ten walls which are longitudinally aligned with each other" or "perpendicular with respect to each other" (*Final Office Action dated October 2, 2003; Page 2*).

For example, with reference to adjacent FIG. 2 of Apps '572 (with identifiers A, B, and C added for ease of reference), the Examiner previously asserted that "a divider

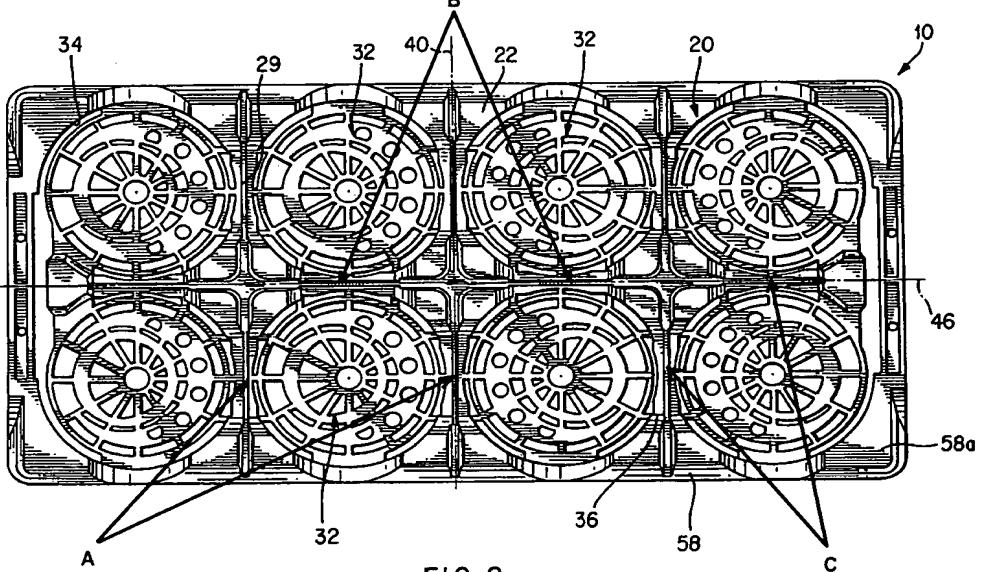


FIG. 2

wall" was disclosed as two parallel walls spaced across a bottle pocket (A), two longitudinally aligned walls (B), or two perpendicular walls (C). Obviously, as pointed out in the Appeal Brief, this pairing of surfaces from different wall structures did not meet the claim language.

Recognizing, but not acknowledging, the impropriety of his earlier rationale, the Examiner now moves on to an even more frivolous argument that the "single walled dividers disclosed by the prior art show generally parallel surfaces, one surface corresponding to each

opposed side or face of the single wall" (*Examiner's Answer dated June 18, 2004; Page 4*). In this assertion, Appellant's claimed limitation of "spaced apart" is necessarily absent, as it would prevent any such application of the prior art to the claimed invention. As it is clear to anyone of ordinary skill in the art, a single wall as disclosed in each of the seven cited references does not have "spaced apart" generally parallel surfaces as claimed by Appellant. Typical is wall 29 shown in adjacent FIG. 7 (partial) of Apps '572. Once again the Examiner has not addressed Appellant's specific claim language as required by M.P.E.P. § 1208 (Page 1200-19, 8th edition). Had the Examiner ever attempted to fulfill this obligation, he would have realized the fallacy of his position.

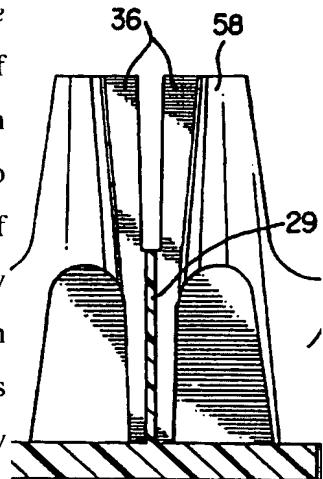


FIG. 7

Furthermore, the Examiner's aside that the walls 29 of Apps '572 have different sections is irrelevant as the sections are neither spaced apart nor does each section extend between the same two columns or between the same column and the wall structure as claimed by Appellant.

In addition, the Examiner attempts to disclaim his previous admission that "[t]he primary references disclose the invention except for the divider wall being a spaced surface construction" (*Final Office Action dated October 2, 2003; Page 3*). He now asserts that "[t]his statement is meant to state that the double walled configuration disclosed but not claimed is not shown" (*Examiner's Answer; Page 5*). This new assertion is unsupported by the record, while his previous admission correctly represents the references. Further, it is immaterial whether the Examiner believes that a "double walled" configuration is disclosed by Appellant, since it is not claimed by Appellant. What is at issue is the claimed "spaced apart" surface construction missing from the references cited as the basis for the rejections under 35 U.S.C. §§ 102(b) and 102(e).

Rejection Under 35 U.S.C. § 103(a)

Appellant's claims are patentably distinguishable over the primary references for the reasons stated above and in the Appeal Brief. In the primary references, the single-walled divider walls were merely used to define pockets for the individual bottles contained in adjacent bottle retaining pockets without the capability to substantially bear the structural load of the tray. As described in Appellant's specification (see, for example, p. 9, line 24 - p. 10, line 4), by utilizing divider walls with spaced apart surfaces for each bottle pocket as claimed, Appellant effectively increased the overall strength of the tray and the stability of the individual bottles carried therein while still maintaining a lightweight tray.

Unlike Appellant's claimed invention and each of the primary references, the secondary Cornelius and McGrath references are directed to bottle cases without individual bottle pockets or any interior column structure. The Examiner had previously asserted that McGrath and Cornelius teach divider walls as claimed by Appellant and, without any basis in the prior art for such motivation, that it would have been obvious to modify the primary references to have divider walls with spaced apart surface construction "in order to strengthen the divider wall and to provide a greater amount of separation between bottles in the bottle trays so that the bottles will not touch one another or become damaged due to sudden impact loads on the transporting bottle tray" (*Final Office Action dated October 2, 2003; Page 3*).

The Examiner now attempts to provide motivation to combine the references by offering the following reasoning "based" on Cornelius, which discloses compartments 10 without interior columns that are designed to hold 6-packs of bottles contained within an external support structure (i.e., the 6-pack carton):

The motivation found within Cornelius states that the carrier is unusually rugged, reinforced construction comprising an essentially thin walled shell structure. The double walled partitions 11 and 12 are reinforced with webs 15. The reinforced

yet thin walled structure is lightweight making it easier to carry and less costly to haul when many carriers are being used.

(Examiner's Answer; Page 6)

In fact, Cornelius does not support the Examiner's conclusory statement that the wall structure is utilized to make the carrier easier to carry and less costly to haul. Instead, Cornelius explains that “[p]acking and handling equipment ... are all equipped and proportioned to accommodate wooden 6-pack carriers” such that partitions 11 and 12 are necessary in order “to compensate for the thicknesses customarily afforded by the wooden boards, slats, and dividers of wooden carriers, whereby this plastic carrier is fully interchangeable with the wooden carriers” (*see Cornelius, col. 1, lines 29-34 and col. 5, lines 65-74*). As such, Cornelius needs the thickness provided by dividers 11,12 in order to ensure that the plastic carriers are compatible *for size considerations* with conventional packing and handling equipment designed for wooden carriers. This does not provide a motivation for the combinations now asserted.

The Examiner continues, without reliance on the prior art, with the assertion:

There is further motivation to combine when one considers that the spacing of the double wall structure provides added protection that adjacent bottles will not touch or contact each other and that the double wall structure provides a fail-safe provision should one of the walls be punctured, torn or damaged, the other wall still provides protection to the lower portions of the bottle.

(Examiner's Answer; Page 6)

Quite to the contrary, the protection provided for adjacent bottles within a 6-pack loaded in Cornelius's tray is the external paperboard carton, and not any part of the tray itself. There is no motivation to combine Cornelius with the cited primary references. Further,

there is no indication in the art that there is any concern that “adjacent bottles will not touch or contact each other” nor is there any need mentioned in the prior art for a “fail-safe provision should one of the walls be punctured, torn or damaged.” Instead, McGrath, the Examiner’s own reference, discloses that it is *intended* that the bottles touch one another (see McGrath, col. 6, lines 30-43; FIG. 9).

The Examiner attempts to explain away the lack of motivation to combine McGrath, which discloses a tray with a single partition 47 and several bottles placed on either side thereof, with the primary references by stating that “McGrath is the teaching or secondary reference, the primary references are relied upon for the more than one partition limitation and the interior column structure” (*Examiner’s Answer; Page 6*). In actuality, there is no motivation to combine the references expressly because McGrath and Cornelius are directed to different types of crates compared with Appellant’s invention and the primary references. Without motivation to combine McGrath or Cornelius with the primary references, there is no teaching or suggestion to modify the single walls absent hindsight gained from Appellant’s disclosure. The lack of motivation is further accentuated by McGrath and Cornelius teaching away from the use of individual bottle pockets.

Even if there were any reason to combine McGrath with any of the other references, the combination would not teach the claimed inventions. For example, contrary to the Examiner’s assertion that “[t]he upwardly extending portions 46 on the divider structure of McGrath suggests interior columns” (*Examiner’s Answer; Page 6*), McGrath discloses that “[t]he bottle support surfaces 46 are provided within the crate in the form of a partition 47” (see McGrath, col. 8, lines 44-46; FIG. 24). It is clear that surfaces 46 are not equivalent to an interior column structure as claimed by Appellant.

The Examiner further states that “[t]he modification of the dividers to be double-walled doesn’t modify the number of partitions or the interior columns” and “[t]he

modification would not change the size or number of pockets or the fact that one bottle is received in each pocket" (*Examiner's Answer; Page 6*). Again, the Examiner is skirting the issue of motivation and improperly applying hindsight. Simply stating that a modification can be made to the primary references does not provide the motivation to do so. The references clearly do not appreciate the bottle stability provided by Appellant's claimed invention wherein a divider wall with spaced apart surface construction is included in each bottle retaining pocket to provide greater support to the single bottle it receives.

For the reasons discussed above and in the Appeal Brief, Appellant believes the recited rejections of claims 1-39 are in error. Thus, reversal is respectfully requested.

Respectfully submitted,

WILLIAM P. APPS

By: Stephanie M. Mansfield
Stephanie M. Mansfield
Registration No. 43,773
Attorney/Agent for Applicant

Date: August 16, 2004

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351